



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,649	01/03/2001	Eugene de Juan JR.	55535 (1699)	1507

7590 07/12/2002

Dike, Bronstein, Roberts & Cushman, LLP
Intellectual Property Practice Group of
EDWARDS & ANGELL LLP
130 Water Street
Boston, MA 02109

EXAMINER

JEFFERY, JOHN A

ART UNIT PAPER NUMBER

3742

DATE MAILED: 07/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/756,649

Applicant(s)

DE JUAN ET AL.

Examiner

John A. Jeffery

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 12-16, 21-23 and 44 is/are rejected.
- 7) ☒ Claim(s) 5-11, 17-20, 24-43 and 45-60 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because of the following informalities:

Figs. 1, 2, and 7-14: Reference numerals must be added adjacent all significant structural elements. Currently, there are no reference numerals in the above figures. Applicant is reminded to amend the specification accordingly in conjunction with the drawing change.

Figs. 8, 9: All text and dimensions must be removed for clarity.

Fig. 8: An additional figure legend must be added to the subfigure (e.g., "Fig. 8A").

Fig. 12: An additional figure legend must be added to the subfigure.

Fig. 13: The term "Frequency" is misspelled.

The response to this action must include a separate letter addressed to the examiner and contain: (1) sketches showing in red the drawing changes required above and (2) a request that the examiner approve the changes as shown on the sketches.

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketches with proposed corrections in red ink is required in response to this office action, and may not be deferred.

Specification

The disclosure is objected to because of the following informalities:

On Page 10, line 3, "Figs. 1-1" is unclear since there is no figure by that label. Correction is required.

Claim Objections

Claims 5-11, 17-20, 24-43, and 45-60 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple independent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claims 1-4, 12-16, and 21-23 are objected to because of the following informalities:

Claim 1: In line 2, the term "may be" must be changed to "is" since the claims must positively recite what the claim is--not what it might or could be.

Claim 12: For the same reason, in line 4, "may be" must be deleted.

Claim 14: In line 3, "can be" must be changed to "is."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 22 and 23/22/21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22: The claim is incomplete because there is no period at the end of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 12-16, and 21-23, and 44 are rejected under 35 USC 102(b) as being anticipated by SU733670. SU733670 discloses a surgical instrument for use in cornea removal surgery comprising a strain gauge which detects changes in pressure from the underlying tissue during use. The detected pressure from the strain gauge is used as a control signal to change the audible tone or sound volume thereby providing audible feedback to the surgeon during use.

Other Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The art should be both separately considered and considered in conjunction with the previously cited prior art when responding to this action.


DE 126, Nissan, Tanimoto, US 902, EP 443, US 046, US 280, US 934, US 671, JP 031, US 805, Sukthankar, US 894, Dargahi, US 987, US 511, JP 425, JP 978, US 409 disclose surgical instruments with detectors to provide feedback to the user regarding detected force and/or position.

Art Unit: 3742

Conclusion

Any inquiry concerning this or earlier communications from the examiner should be directed to John A. Jeffery at telephone number (703) 306-4601 or fax (703) 305-3463. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 4:30 PM EST. The examiner can also be reached on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.


JOHN A. JEFFERY
PRIMARY EXAMINER

7/8/02